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Paper No. 13
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Sherwin-Williams Company

Serial No. 75/860,737

Vivien Y. Tsang for The Sherwin-Williams Company.

Catherine K. Krebs, Trademark Examining Attorney, Law
Office 108 (David Shallant, Managing Attorney).

Before Hairston, Wendel and Bucher, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

This is an appeal from the Trademark Examining
Attorney's final refusal to register the mark PALETTE MATCH
for "interactive computer programs and computer software
for use in creating, displaying and visualizing paint
colors and decorating features."¹

¹ Serial No. 75/860,737, filed November 30, 1999. The
application is based on an intent-to-use under Trademark Act
Section 1(b).

Registration has been refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, as applied to the identified goods, the mark is merely descriptive of them.

Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

According to the Examining Attorney, applicant's computer software is designed to "provide consumers with the means of determining a range of contrasting or complementary colors based on a consumer's selection of a color or colors." Thus, the Examining Attorney argues that the mark PALETTE MATCH describes the function of applicant's goods which is to establish "the palette or range of colors that 'work' or match with a given color choice." (Brief, p. 3).

In support of the refusal to register, the Examining Attorney made of record definitions of the words "palette" and "match" taken from Merriam-Webster's Collegiate Dictionary (10th ed. 1993). The word "palette" is defined as "1: a thin oval or rectangular board or tablet that a painter holds and mixes pigments on; the set of colors put on the palette; 2: a particular range, quality, or use of color; a comparable range, quality, or use of available elements especially in another art (music)." The word

"match" is defined as, inter alia, "a pair suitably associated (carpet and curtains are a ~)." In addition, the Examining Attorney submitted excerpts from the NEXIS database wherein the words "palette" and "match" are used in connection with paints and/or home decorating.² The following are representative examples:

If this is a crusade, its most effective weapon may be the computer. Austin sees a designer being able to select two distinct colors and the computer producing a complete palette to match the colors of leaves, bark, mulch, paving, garden furniture, house trim and the rest. (The Orlando Sentinel; June 5, 1999);

In the kitchen, a 1930's turquoise Hoosier cabinet (a free-standing pantry) is filed with Fiesta ware, the colorful dinnerware from the 1930's. "You could say the Fiesta ware is our color palette - we match everything in the house to it," Bert said. (The Baltimore Sun; April 18, 1999); and

² We note that the Examining Attorney did submit several Nexis excerpts wherein the words "palette" and "match" are used in connection with computer software. It would appear from these articles that the word "palette" has become a term of art in the computer field that is immediately identifiable with subsets of displayable colors. In fact, one excerpt the Trademark Examining Attorney pulled from an Apple Macintosh Web site uses the exact combination ("palette match") in a highly technical sense to explain Mac's routine for managing the colors of pixels between different computerized applications.

While applicant's goods are computer software, these highly technical excerpts from Nexis have little probative value because both words in applicant's mark are being used in the more traditional senses of these words, namely "palette" to suggest a combination of colors and "match" as a verb form meaning "provide a harmonious counterpart." Applicant is not using this designation in the highly technical context of computer graphics system software finding the closest or best available pixel colors.

In real life, he has designed his getaway for easy upkeep. The retreat is done in a sandy palette that matches his pet Weimaraner. It does have white floors.

(The Washington Post; August 20, 1998).

Further, the Examining Attorney submitted the following information about applicant's goods downloaded from applicant's Web site:

With Palette Match, a click of your mouse can find the color you want and tell you where to get it before you open a single can of paint. Your old paintbrush could never do that.

.

Is choosing the right paint color giving you a headache? We've made choosing a paint systematically simple. By grouping our paints into four distinct color collections and dividing them into convenient color palettes, choosing the right paint color has never been easier.

Based on the foregoing, the Examining Attorney argues that the mark PALETTE MATCH is merely descriptive of the identified goods.

In response to this refusal, applicant argues that its mark is at most suggestive of the identified goods. In particular, applicant maintains that its computer program will provide consumers with the ability to view contrasting and complementary colors based on a single color selection. However, applicant argues that its goods are not intended to "match any color palette in any manner." (Brief, p. 7).

A mark is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods or services. In re Abcor Development Corp., 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree of particularity." Plus Products v. Medical Modalities Associates, Inc., 211 USPQ 1199, 1204-05 (TTAB 1981); Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949, 952 (TTAB 1981); In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); and In re Diet Tabs, Inc., 231 USPQ 587, 588 (TTAB 1986).

If, however, when the goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See In re Abcor Development Corp., supra at 218; and In re Atavio, 25 USPQ2d 1361, 1362 (TTAB 1992). To the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive one, such doubt is to be resolved in applicant's favor. In re Atavio, supra at 1363.

Most of the Nexis excerpts made of record by the Examining Attorney merely show the words "palette" and "match" in close proximity with one another, and not as a single term. Moreover, except for references to applicant's computer program, none of these excerpts relate to a paint vendor providing an interactive tool for retail paint customers. Certainly, there is nothing in the record to suggest that competitors need to use this exact terminology to describe their own interactive, colorization programs.

In our view, a visitor to applicant's web site would not obtain an immediate idea of the particular nature of applicant's computer programs for use in creating, displaying and visualizing paint colors and decorating features upon seeing the mark PALETTE MATCH used in connection therewith. Rather, PALETTE MATCH used for such computer programs requires a multistage reasoning process before one is able to determine the specific nature of the goods. For example, the homeowner, interior decorator or painting contractor visiting applicant's Web site chooses a color from among the various color collections (or "palettes") offered by applicant and then applicant's computer program selects a limited number of trim colors to "match" the main color chosen by the prospective customer.

Accordingly, because PALETTE MATCH does not immediately describe with particularity the nature of applicant's goods, it is not merely descriptive of them.

Decision: The refusal to register under Section 2(e)(1) of the Act is reversed.